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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/631,878
Filing Date: July 31, 2003
Appellant(s): HIND ET AL.

Wayne P. Bailey
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/07/2008 appealing from the Office action mailed 11/16/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

GROUND(S) OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief.

Claims 1 – 4, 6 – 8, 19 – 22, 24 – 28 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoshi et al. ('Hoshi' herein after) (US 2002/0083043 A1).

Claims 9 – 18, 23, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshi et al. ('Hoshi' herein after) (US 2002/0083043 A1) as applied to claims 1 – 4, 6 – 8, 19 – 22, 24 – 28 and 30 above, and further in view of Fedorovskaya et al. ('Fedorovskaya' herein after) (2004/0101212 A1).

NEW GROUND(S) OF REJECTION

Claim 31 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2001/0044588 A1	James R. Mault	11-2001
US 2002/0009119 A1	Matthew et al.	01-2002
US 2002/0083043 A1	Hoshi et al.	06-2002
US 2004/0101212 A1	Fedorovskaya et al.	05-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 31 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 31 recites “a computer program product in a computer recordable-type medium” and according to the antecedent basis provided by applicant in specification on page 14 lines 9 – 27, a covered embodiment is propagation media. Propagation media in the context of this disclosure covers signals and carrier waves, which are not a manufacture within the meaning of 101, and electrical connections and optical fibers, on which the program is still unavailable to the processor. In such embodiments, the program is still unable to act as a computer component and have its functionality realized.

Furthermore, when nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier

signal does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”). Such a result would exalt form over substance. In re *Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) (“[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims.

Response to Arguments

1. Claims 1 – 4 and 6 – 31 are pending in this Office Action. After a further search and a thorough examination of the present application, claims 1 – 4 and 6 – 31 remain rejected.
2. Applicant's arguments filed with respect to claims 1 – 4 and 6 – 31 have been fully considered but they are not persuasive.

Applicant argues that there is no teaching in Mault alone or in combination with Matthew of “an electronic consumable” and “wherein the sensor is activated by a user action by manipulating an object of the electronic consumable to collect information about the user's behavior as the user consumes the electronic consumable and wherein embedded code of the object causes the information to be recorded in response to the user manipulating the object.”.

In response to Applicant's argument, the Examiner submits that Mault in combination with Matthew discloses the electronic consumable as defined by applicant

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on page 9 of 19 an eBook, this is disclosed in Mault in paragraph 42. Furthermore, Mault in combination with Matthew discloses the wherein the sensor is activated by a user action by manipulating an object of the electronic consumable to collect information about the user's behavior as the user consumes the electronic consumable and wherein embedded code of the object causes the information to be recorded in response to the user manipulating the object in paragraphs 15 and 39 of Mault. In paragraph 15 of Mault there is an illustration of a temperature sensor that is or could be inserted into an orifice, this is an action possibly made by the user, therefore user manipulated the object and activated the sensor. Therefore the arguments made by the applicant do not overcome the prior art of record and thus the rejection is maintained.

Other claims recite the same subject matter and for the same reasons as cited above the rejection is maintained.

Hence, Applicant's arguments do not distinguish the claimed invention over the prior art of record. In light of the foregoing arguments, the 103 rejections are sustained.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1 – 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over James R Mault ('Mault' herein after) (US 2001/0044588 A1) further in view of Matthew et al. ('Matthew' herein after) (US 2002/0009119 A1).

With respect to claim 1.

Mault discloses a system for collecting information about a user of an electronic consumable, comprising: an electronic consumable displayed using an apparatus, the apparatus having an input device and a sensor (paragraphs 2, 14 and 42, Mault); wherein the sensor is activated by a user action to collect information about the user's behavior as the user consumes the electronic consumable (paragraphs 7 and 15, Mault) and wherein embedded code of the object causes the information to be recorded in response to the use manipulating the object (paragraphs 7 and 15, Mault).

However Mault does not disclose the sensor being activated by a user action explicitly as disclosed.

Matthew teaches the user action activation of the sensor (paragraph 46, Matthew) and embedded code of the object causes the information to be recorded in response to the use manipulating the object (paragraph 46, Matthew).

It would have been obvious to one of ordinary skill in the art of data processing at the time of the present invention to combine the teachings of cited references because they both are used to monitor and process data using sensors. Furthermore, the user activation being used to activate the sensor would make the sensor usage more effective (paragraphs 35, 39 and 45–46, Matthew).

5. Claims 2 – 4 and 6 – 8 are rejected under the same rationale given for claim 1.

The citations of the elements claimed and taught are listed below.

With respect to claim 2.

Mault modified teaches the system of claim 1, wherein the sensor is a device chosen from the group consisting of: a webcam, an infra red camera, an audio input, a video input, and a temperature sensor (paragraph 15, 42 and 78, Mault).

With respect to claim 3.

Mault modified teaches the system of claim 1, wherein the information collected is reported to a remote location (paragraph 2 and 14, Mault).

With respect to claim 4.

Mault modified teaches the system of claim 1, wherein by activating the input device, the user causes the information to be collected (paragraph 46, Matthew).

With respect to claim 6.

Mault modified teaches the system of claim 1, wherein the object of the electronic consumable can only be stored in containers that allow the embedded code of the object to function (paragraph 39, 42 and 59, Mault).

With respect to claim 7.

Mault modified teaches the system of claim 1, wherein the information is analyzed using data mining techniques (paragraph 7 and 14, Mault).

With respect to claim 8.

Mault modified teaches the system of claim 1, wherein the user can configure the collection and reporting of information (paragraph 7 and 14, Mault).

With respect to claim 9.

Mault discloses a system for collecting information about a user of an electronic consumable, comprising: an apparatus capable of displaying an electronic consumable; an electronic consumable comprising documents and objects (paragraphs 2, 14 and 42, Mault); wherein the documents and objects include instructions for automatically monitoring and reporting user behavior; and wherein a user action triggers the monitoring and reporting of the user behavior (paragraphs 7 and 15, Mault).

However Mault does not disclose the sensor being activated by a user action explicitly as disclosed.

Matthew teaches the user action activation of the sensor (paragraph 46, Matthew).

It would have been obvious to one of ordinary skill in the art of data processing at the time of the present invention to combine the teachings of cited references because

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they both are used to monitor and process data using sensors. Furthermore, the user activation being used to activate the sensor would make the sensor usage more effective (paragraph 35, 39 and 45 – 46, Matthew).

6. Claims 10 – 18 are rejected under the same rationale given for claim 9. The citations of the elements claimed and taught are listed below.

With respect to claim 10.

Mault modified teaches the system of claim 9, wherein the user behavior reported comprises how long the user looked at a first page of the document (paragraph 15, 42 and 78, Mault)..

With respect to claim 11.

Mault modified teaches the system of claim 9, wherein the user behavior reported comprises the time between the user opening an object and closing the object (paragraph 15, 42 and 78, Mault)..

With respect to claim 12.

Mault modified teaches the system of claim 9, further comprising a sensor as part of the apparatus, wherein the sensor collects biological information about the user (paragraph 15, 42 and 78, Mault)..

With respect to claim 13.

Mault modified teaches the system of claim 12, wherein the sensor is an infrared sensor, and wherein the biological information comprises the body temperature of the user as determined from the sensor (paragraph 15, 42 and 78, Mault)..

With respect to claim 14.

Mault modified teaches the system of claim 12, wherein the sensor is a camera, and wherein the biological information comprises facial expressions of the user (paragraph 15, 42 and 78, Mault).

With respect to claim 15.

Mault modified teaches the system of claim 14, wherein the facial expressions are classified according to a facial expression recognition algorithm (paragraph 15, 42 and 78, Mault)..

With respect to claim 16.

Mault modified teaches the system of claim 9, wherein the user behavior is analyzed using data mining techniques (paragraph 7 and 14, Mault).

With respect to claim 17.

Mault modified teaches the system of claim 9, wherein the objects can only be stored in containers that allow embedded code of the object to function (paragraph 7 and 14, Mault).

With respect to claim 18.

Mault modified teaches the system of claim 9, wherein the user can configure the collection and reporting of information by the system (paragraph 7 and 14, Mault).

With respect to claim 19.

Mault discloses a method of collecting information about a user of an electronic consumable, comprising the steps of: storing an electronic consumable on an apparatus, the apparatus providing means for displaying the electronic consumable (paragraphs 2, 14 and 42, Mault); in response to a user action, collecting information about the user, wherein the information is collected according to embedded code in an object of the electronic consumable; and reporting the information across a network (paragraphs 7 and 15, Mault).

However Mault does not disclose the sensor being activated by a user action explicitly as disclosed.

Matthew teaches the user action activation of the sensor (paragraph 46, Matthew).

It would have been obvious to one of ordinary skill in the art of data processing at the time of the present invention to combine the teachings of cited references because

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they both are used to monitor and process data using sensors. Furthermore, the user activation being used to activate the sensor would make the sensor usage more effective (paragraph 35, 39 and 45 – 46, Matthew).

7. Claims 20 – 24 are rejected under the same rationale given for claim 19. The citations of the elements claimed and taught are listed below.

With respect to claim 20.

Mault modified teaches the method of claim 19, wherein the reported information is analyzed using data mining techniques (paragraph 7 and 14, Mault).

With respect to claim 21.

Mault modified teaches the method of claim 19, wherein the information is collected by sensors of the apparatus (paragraph 15, 42 and 78, Mault).

With respect to claim 22.

Mault modified teaches the method of claim 21, wherein the sensors are selected from the group consisting of: a webcam, an infra red camera, an audio input, a video input, and a temperature sensor (paragraph 15, 42 and 78, Mault).

With respect to claim 23.

Mault modified teaches the method of claim 21, wherein the information includes biological information about the user (paragraph 15, 42 and 78, Mault).

With respect to claim 24.

Mault modified teaches the method of claim 19, wherein the object of the electronic consumable can only be stored in containers that allow the embedded code of the object to function (paragraph 39, 42 and 59, Mault).

With respect to claim 25.

Mault discloses a system for collecting information about a user of an electronic consumable, comprising: means for storing an electronic consumable on an apparatus, the apparatus providing means for displaying the electronic consumable (paragraphs 2, 14 and 42, Mault); in response to a user action, means for collecting information about the user, wherein the information is collected according to embedded code in an object of the electronic consumable; means for reporting the information across a network (paragraphs 7 and 15, Mault).

However Mault does not disclose the sensor being activated by a user action explicitly as disclosed.

Matthew teaches the user action activation of the sensor (paragraph 46, Matthew).

It would have been obvious to one of ordinary skill in the art of data processing at the time of the present invention to combine the teachings of cited references because

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they both are used to monitor and process data using sensors. Furthermore, the user activation being used to activate the sensor would make the sensor usage more effective (paragraph 35, 39 and 45 – 46, Matthew).

8. Claims 26 – 30 are rejected under the same rationale given for claim 25. The citations of the elements claimed and taught are listed below.

With respect to claim 26.

Mault modified teaches the system of claim 25, wherein the reported information is analyzed using data mining techniques (paragraph 7 and 14, Mault).

With respect to claim 27.

Mault modified teaches the system of claim 25, wherein the information is collected by sensors of the apparatus (paragraph 15, 42 and 78, Mault).

With respect to claim 28.

Mault modified teaches the system of claim 27, wherein the sensors are selected from the group consisting of: a webcam, an infra red camera, an audio input, a video input, and a temperature sensor (paragraph 15, 42 and 78, Mault).

With respect to claim 29.

Mault modified teaches the system of claim 27, wherein the information includes biological information about the user (paragraph 15, 42 and 78, Mault).

With respect to claim 30.

Mault modified teaches the system of claim 25, wherein the object of the electronic consumable can only be stored in containers that allow the embedded code of the object to function (paragraph 39, 42 and 59, Mault).

With respect to claim 31.

Mault discloses a computer program product in a computer readable medium, comprising the computer implemented steps of: first instructions for storing an electronic consumable on an apparatus, the apparatus providing means for displaying the electronic consumable; in response to a user action, second instructions for collecting information about the user, wherein the information is collected according to embedded code in an object of the electronic consumable; third instructions for reporting the information across a network; wherein the information includes biological information about the user.

However Mault does not disclose the sensor being activated by a user action explicitly as disclosed.

Matthew teaches the user action activation of the sensor (paragraph 46, Matthew).

It would have been obvious to one of ordinary skill in the art of data processing at the time of the present invention to combine the teachings of cited references because they both are used to monitor and process data using sensors. Furthermore, the user activation being used to activate the sensor would make the sensor usage more effective (paragraph35, 39 and 45 –46, Matthew).

Response to Arguments

9. Claims 1 – 4 and 6 – 31 are pending in this Office Action. After a further search and a thorough examination of the present application, claims 1 – 31 remain rejected. Examiner, in previous office action, gave explanation of claimed limitation and pointed out exact locations in the cited prior art. Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification.

10. Interpretation of Claims-Broadest Reasonable Interpretation

During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).

11. Applicant's arguments filed with respect to claims 1 – 4 and 6 – 31 have been fully considered but they are not persuasive.

First, Applicant argues that there is no teaching in Hoshi that the sensor is activated by a user action to collect information.

In response to Applicant's argument, the Examiner submits that Hoshi teaches that the sensor is activated by a user action, that is the set top box that would be integrated with node 11 would be powered on/off by the user thus it would function to collect information and relay information only when powered on by the user, this would be irrespective of the fact that it could be powered on once and left to be in the activated state (Paragraphs 0145 – 0148). It is inherent from paragraph 0147 that the sensors (thermometers, cameras, and actuators) for monitoring have switches and control mechanisms for operation by the user. Therefore it would be inherent that a user activates the sensor to provide the functions of collecting information or relaying information or displaying information.

Second, Applicant argues that there is no teaching in Hoshi that by activating the input device the user causes the information to be collected or that the user activates the sensor by manipulating an object of the electronic consumable.

In response to Applicant's argument, the Examiner submits that Hoshi teaches that the sensor is activated by a user action, that is the set top box that would be integrated with node 11 would be powered on/off by the user thus it would function to collect information and relay information only when powered on by the user, this would be irrespective of the fact that it could be powered on once and left to be in the activated state (Paragraphs 0145 – 0148). It is inherent from paragraph 0147 that the sensors (thermometers, cameras, and actuators) for monitoring have switches and control

mechanisms for operation by the user. Therefore it would be inherent that a user activates the sensor to provide the functions of collecting information or relaying information or displaying information. Hoshi teaches that by activating the input device the user causes the information to be collected and that the user activates the sensor by manipulating an object of the electronic consumable. In paragraph 0144 Hoshi discloses that the data items stored in node are transmitted in order to analyze the information and the profiles. It also discloses that the data items are transmitted regularly to the system service station.

Third, *In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).*

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument on page 13, a prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. Once such a case is established, it is incumbent upon appellant to go forward with objective evidence of unobviousness. In re Fielder, 471 F.2d 640, 176 USPQ 300 (CCPA 1973).

In response to applicant's argument, to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

"Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

In re Keller, Terry, and Davies, 208 USPQ 871 (CCPA 1981).

"Reason, suggestion, or motivation to combine two or more prior art references in single invention may come from references themselves, from knowledge of those skilled in art that certain references or disclosures in references are known to be of interest in

particular field, or from nature of problem to be solved;" Pro-Mold and Tool Co. v. Great Lakes Plastics Inc. U.S. Court of Appeals Federal Circuit 37 USPQ2d 1626 Decided February 7, 1996 Nos. 95-1171, -1181

"[q]uestion is whether there is something in prior art as whole to suggest desirability, and thus obviousness, of making combination." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al. U.S. Court of Appeals Federal Circuit 221 USPQ 481 Decided Mar. 21, 1984 No 83-1178.

Hence, Applicant's arguments do not distinguish the claimed invention over the prior art of record. In light of the foregoing arguments, the 102 and 103 rejections are sustained.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1 – 4, 6 – 8, 19 – 22, 24 – 28 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoshi et al. ('Hoshi' herein after) (US 2002/0083043 A1).

With respect to claim 1,

Hoshi discloses a system for collecting information about a user of an electronic consumable, comprising: an electronic consumable displayed on an apparatus, the

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apparatus having an input device and a sensor; wherein the sensor is activated by a user action by manipulating an object of the electronic consumable to collect information about the user's behavior as the user consumes the electronic consumable (page 3 paragraph 0058 and 0059, Hoshi) and wherein embedded code of the object causes the information to be recorded in response to the user manipulating the object (paragraph 0146 – 0147, Hoshi).

With respect to claim 2,

Hoshi discloses the system of claim 1, wherein the sensor is a device chosen from the group consisting of: a webcam, an infra red camera, an audio input, a video input, and a temperature sensor (paragraphs 0084 – 0085 & 0239, Hoshi).

With respect to claim 3,

Hoshi discloses the system of claim 1, wherein the information collected is reported to a remote location (Figure 12 and paragraph 0144, Hoshi).

With respect to claim 4,

Hoshi discloses the system of claim 1, wherein by activating the input device, the user causes the information to be collected (paragraph 0144 – 45, Hoshi).

With respect to claim 6,

Hoshi discloses the system of claim 1, wherein the object of the electronic consumable can only be stored in containers that allow the embedded code of the object to function (Figure 7 & 10, Hoshi).

With respect to claim 7,

Hoshi discloses the system of claim 1, wherein the information is analyzed using data mining techniques (paragraph 0140, Hoshi).

With respect to claim 8,

Hoshi discloses the system of claim 1, wherein the user can configure the collection and reporting of information (paragraph 0154, Hoshi).

With respect to claim 19,

Hoshi discloses a method of collecting information about a user of an electronic consumable, comprising the steps of: storing an electronic consumable on an apparatus, the apparatus providing means for displaying the electronic consumable; in response to a user action, collecting information about the user (page 3 paragraph 0058 and 0059, Hoshi), wherein the information is collected according to embedded code in an object of the electronic consumable (paragraph 0146 – 0147, Hoshi); and reporting the information across a network (Figure 12 and paragraph 0144, Hoshi).

With respect to claim 20,

Hoshi discloses the method of claim 19, wherein the reported information is analyzed using data mining techniques (paragraph 0140, Hoshi).

With respect to claim 21,

Hoshi discloses the method of claim 19, wherein the information is collected by sensors of the apparatus (paragraph 0140, Hoshi).

With respect to claim 22,

Hoshi discloses the method of claim 21, wherein the sensors are selected from the group consisting of: a webcam, an infra red camera, an audio input, a video input, and a temperature sensor (paragraphs 0084 – 0085 & 0239, Hoshi).

With respect to claim 24,

Hoshi discloses the method of claim 19, wherein the object of the electronic consumable can only be stored in containers that allow the embedded code of the object to function (Figure 7 & 10, Hoshi).

With respect to claim 25,

Hoshi discloses a system for collecting information about a user of an electronic consumable, comprising: means for storing an electronic consumable on an apparatus, the apparatus providing means for displaying the electronic consumable (paragraph 0058, Hoshi); in response to a user action, means for collecting information about the

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user (paragraph 0059, Hoshi), wherein the information is collected according to embedded code in an object of the electronic consumable (paragraph 0146 – 0147, Hoshi); means for reporting the information across a network (Figure 12 and paragraph 0144, Hoshi).

With respect to claim 26,

Hoshi discloses wherein the reported information is analyzed using data mining techniques (paragraph 0140, Hoshi).

With respect to claim 27,

Hoshi discloses wherein the information is collected by sensors of the apparatus (paragraph 0140, Hoshi).

With respect to claim 28,

Hoshi discloses wherein the sensors are selected from the group consisting of: a webcam, an infra red camera, an audio input, a video input, and a temperature sensor (paragraphs 0084 – 0085 & 0239, Hoshi).

With respect to claim 30,

Hoshi discloses wherein the object of the electronic consumable can only be stored in containers that allow the embedded code of the object to function (Figure 7 & 10, Hoshi).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 9 – 18, 23, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshi et al. ('Hoshi' herein after) (US 2002/0083043 A1) as applied to claims 1 – 4, 6 – 8, 19 – 22, 24 – 28 and 30 above, and further in view of Fedorovskaya et al. ('Fedorovskaya' herein after) (2004/0101212 A1).

With respect to claim 9,

Hoshi discloses a system for collecting information about a user of an electronic consumable, comprising: an apparatus capable of displaying an electronic consumable; an electronic consumable comprising documents and objects; wherein the documents

and objects include instructions for automatically monitoring and reporting user behavior; and wherein a user action triggers the monitoring and reporting of the user behavior (paragraphs 0058, 0059 and 0239, Hoshi).

Hoshi does not explicitly disclose monitoring and reporting user behavior as claimed.

Fedorovskaya teaches monitoring and reporting of user behavior (paragraph 0036 and 0047, Fedorovskaya).

It would have been obvious to one of ordinary skill in the art of data processing at the time of the present invention to combine the teachings of cited references because the analysis of the captured user behavior would lead to an accurate profiling of the users (paragraph 0062, Fedorovskaya). Furthermore, the classifications of emotions portrayed in pictures help in reviewing the information (paragraph 0009, Fedorovskaya). Also the monitoring/tagging of the user behavioral reactions and storing the information is taught in Fedorovskaya paragraphs 0036 – 38) and reporting the monitored, tagged user behavior would lead to accurate profiling of the users.

With respect to claim 10,

Fedorovskaya teaches wherein the user behavior reported comprises how long the user looked at a first page of the document (paragraph 0042, 0047, Fedorovskaya).

With respect to claim 11,

Hoshi discloses wherein the user behavior reported comprises the time between the user opening an object and closing the object (paragraph 0144, Hoshi).

With respect to claim 12,

Hoshi discloses further comprising a sensor as part of the apparatus (paragraph 0239, Hoshi), wherein the sensor collects biological information about the user (paragraph 0043 – 47, Fedorovskaya).

With respect to claim 13,

Fedorovskaya teaches wherein the sensor is an infra red sensor, and wherein the biological information comprises the body temperature of the user as determined from the sensor (paragraph 0043, Fedorovskaya).

With respect to claim 14,

Fedorovskaya teaches wherein the sensor is a camera, and wherein the biological information comprises facial expressions of the user (paragraph 0044 and 0046, Fedorovskaya).

With respect to claim 15,

Fedorovskaya teaches wherein the facial expressions are classified according to a facial expression recognition algorithm (paragraph 0068, Fedorovskaya).

With respect to claim 16,

Hoshi discloses wherein the user behavior is analyzed using data mining techniques (paragraph 0140, Hoshi).

With respect to claim 17,

Hoshi discloses wherein the objects can only be stored in containers that allow embedded code of the object to function (Figure 7 & 10, Hoshi).

With respect to claim 18,

Hoshi discloses wherein the user can configure the collection and reporting of information by the system (paragraph 0154, Hoshi).

With respect to claim 23,

Hoshi discloses the method of claim 21, wherein the information includes biological information about the user (paragraph 0239, Hoshi).

Hoshi does not explicitly disclose the biological information as claimed.

Fedorovskaya teaches the biological information (paragraph 0043 – 47, Fedorovskaya).

It would have been obvious to one of ordinary skill in the art of data processing at the time of the present invention to combine the teachings of cited references because the analysis of the captured user behavior would lead to an accurate profiling of the

users (paragraph 0062, Fedorovskaya). Furthermore, the classifications of emotions portrayed in pictures help in reviewing the information (paragraph 0009, Fedorovskaya). Also the monitoring/tagging of the user behavioral reactions and storing the information is taught in Fedorovskaya paragraphs 0036 – 38) and reporting the monitored, tagged user behavior would lead to accurate profiling of the users.

With respect to claim 29,

Hoshi discloses the method of claim 27, wherein the information includes biological information about the user (paragraph 0239, Hoshi).

Hoshi does not explicitly disclose the biological information as claimed.

Fedorovskaya teaches the biological information (paragraph 0043 – 47, Fedorovskaya).

It would have been obvious to one of ordinary skill in the art of data processing at the time of the present invention to combine the teachings of cited references because the analysis of the captured user behavior would lead to an accurate profiling of the users (paragraph 0062, Fedorovskaya). Furthermore, the classifications of emotions portrayed in pictures help in reviewing the information (paragraph 0009, Fedorovskaya). Also the monitoring/tagging of the user behavioral reactions and storing the information is taught in Fedorovskaya paragraphs 0036 – 38) and reporting the monitored, tagged user behavior would lead to accurate profiling of the users.

With respect to claim 31,

Hoshi discloses a computer program product in a computer readable medium, comprising the computer implemented steps of: first instructions for storing an electronic consumable on an apparatus, the apparatus providing means for displaying the electronic consumable (paragraph 0058, Hoshi); in response to a user action, second instructions for collecting information about the user (paragraph 0059, Hoshi), wherein the information is collected according to embedded code in an object of the electronic consumable (paragraph 0146 – 0147, Hoshi); third instructions for reporting the information across a network (Figure 12 and paragraph 0144, Hoshi); wherein the information includes biological information about the user.

Hoshi does not explicitly disclose the biological information as claimed.

Fedorovskaya teaches the biological information (paragraph 0043 – 47, Fedorovskaya).

It would have been obvious to one of ordinary skill in the art of data processing at the time of the present invention to combine the teachings of cited references because the analysis of the captured user behavior would lead to an accurate profiling of the users (paragraph 0062, Fedorovskaya). Furthermore, the classifications of emotions portrayed in pictures help in reviewing the information (paragraph 0009, Fedorovskaya). Also the monitoring/tagging of the user behavioral reactions and storing the information is taught in Fedorovskaya paragraphs 0036 – 38) and reporting the monitored, tagged user behavior would lead to accurate profiling of the users.

(10) Response to Argument

A.1 Claims 1 – 4, 8; A.10 Claims 19, 21 – 23, 25, 27 – 29 and 31; A.11 Claims 20 and 26; and A.12 Claims 24 and 30

Appellant argues that Mault and Matthew alone or in combination do not teach “an electronic consumable displayed on an apparatus”, “wherein the sensor is activated by a user action by manipulating an object of the electronic consumable to collect information about the user’s behavior as the user consumes the electronic consumable” and “where embedded code of the object causes the information to be recorded”.

Examiner respectfully disagrees as Mault and Matthew in combination teach “an electronic consumable displayed on an apparatus” in Figures 3 and 4 and is also explained in paragraphs 42 and 56 of Mault. Mault teaches in detail how the temperature is displayed in paragraphs 7, 16, 36 and 56 and paragraph gives a detail on the examples of the computing device which includes an interactive television component. Furthermore Mault recites in paragraph 42 “The computing device may contain a transceiver card, so that wireless transmissions from one or sensor system can be detected. The sensor 10 and the computing device 20 can be an integrated device. For example, a PDA with a temperature monitoring accessory can be used.” And a temperature sensor is claimed in claim 2 of the instant application.

Furthermore, Mault and Matthew teaches “wherein the sensor is activated by a user action by manipulating an object of the electronic consumable to collect information about the user’s behavior as the user consumes the electronic consumable” in

paragraphs 15 and 39 of Mault. In paragraph 15 of Mault there is an illustration of a temperature sensor that is or could be inserted into an orifice, this is an action possibly made by the user, therefore user manipulated the object and activated the sensor. The applicant indicated that the temperature sensor is not an object of the electronic consumable, this is erroneous understanding on the part of the appellant as it is clearly explained in Figure 4 and paragraphs 42 and 56, Mault, that the temperature sensor is an object of the electronic consumable and paragraphs 45 – 46 of Matthew and "where embedded code of the object causes the information to be recorded" is taught in paragraphs 7, 16 – 17 of Mault.

A. 2 Claim 6; A. 9 Claim 17; and A.10 Claims 19, 21 – 23, 25, 27 – 29 and 31

Appellant argues that Mault and Matthew alone or in combination do not teach "wherein the object of the electronic consumable can only be stored in containers that allow the embedded code of the object to function".

Examiner respectfully disagrees as Mault and Matthew in combination teach "wherein the object of the electronic consumable can only be stored in containers that allow the embedded code of the object to function", in paragraphs 42 and 59 of Mault, it is explained in detail as to how the object of the electronic consumable is taught in Mault and further how the information is stored.

A. 3 Claim 7; and A. 8 Claim 16

Appellant argues that Mault and Matthew alone or in combination do not teach “wherein the information is analyzed using data mining techniques”.

Examiner respectfully disagrees as Mault and Matthew in combination teach “wherein the information is analyzed using data mining techniques”, in paragraphs 16, 59 and 66 of Mault it is explained how this information is analyzed and how the computing device preferably comes equipped with the software to analyze the data being collected.

A. 4 Claims 9, 12 – 14 and 18; A. 5 Claim 10; A. 6 Claim 11; and A. 7 Claim 15

Appellant argues that Mault and Matthew alone or in combination do not teach “wherein the documents and objects include instructions for automatically monitoring and reporting user behavior”.

Examiner respectfully disagrees as Mault and Matthew in combination teach “wherein the documents and objects include instructions for automatically monitoring and reporting user behavior”. Mault teaches the monitoring of the data in detail in paragraphs 7, 14 – 17, 36 and 42. Mault discloses that the information/data is stored, analyzed and monitored; also software is used to aid in diagnosis and analysis. Furthermore, in paragraph 66 of Mault it is also explained how if the temperature range deviates it would trigger alerts, warnings, and notifications according to the environment.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

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Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Navneet K. Ahluwalia/

Examiner, Art Unit 2166

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Jack Harvey/

Director, Technology Center 2100

Conferees:

Supervisory Patent Examiner

/Hosain T Alam/

Supervisory Patent Examiner, Art Unit 2166

Mohammad Ali, AU 2169

/Mohammad Ali/

Supervisory Patent Examiner, Art Unit 2169